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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/238,821 01/28/99 BIGUS

J R0998-238 L

EXAMINER

TM02/1122

STEVEN W ROTH
IBM CORPORATION
DEPARTMENT 917
3605 HIGHWAY 52 NORTH
ROCHESTER MN 55901-7829

ART UNIT	PAPER NUMBER
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2164

DATE MAILED:

11/22/00

FINAL Response Due 02/22/01
mail 01/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

1 DEC 00 11:30

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Office Action Summary

Application No.
09/238,821

Applicant(s)

Bigus

Examiner

Hani Kazimi

Group Art Unit
2164



☒ Responsive to communication(s) filed on Sep 8, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-52 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-52 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2164

DETAILED ACTION

1. This communication is in response to the amendment filed on September 8, 2000. The rejections cited are as stated below.

Status of Claims

2. Of the original claim 1, claim, has been amended and claims 2-52 have been added in the preliminary amendment filed on May 24, 1999. In the amendment filed on September 8, 2000, claim 47 has been canceled, and claims 1, 11, 20, 24, 34, 43, 46, 48, 49, and 50 have been amended. Therefore, claims 1-52 are under prosecution in this application.

Summary of Office Action

3. Applicants' arguments filed on September 8, 2000 have been fully considered, and discussed in the next section below or within the following rejections are not deemed to be persuasive. Therefore, the pending claims are rejected as being unpatentable over the art cited below, and Applicants' request for allowance is respectfully denied.

Response to Applicant's Amendment

4. The Examiner acknowledges Applicants' amended claim 46 and therefore withdraws the prior office action's rejection under 35 U.S.C. 112, second paragraph. Applicants' remaining traversals are discussed under the 35 U.S.C. § 102 and § 103 rejections below.

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Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 11, 13, 14, 18, 34, 36, 37, and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Camaisa et al. US Pat. No. 5,845,263 as discussed in paragraph 5 of paper number 5.

Further, Camaisa teaches that said customer device being moved by a customer from a first position to a second position, said second position being within range of said wireless transmission, said order information being received after said customer device is moved to said second position (column 4, lines 17-63, column 6, lines 26-52, column 11, lines 20-45, column 12, line 61 thru column 13, line 10, and column 14, lines 20 -34).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

9. Claims 1-10, 12, 15-17, 19-33, 35, 38-40, and 42-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camaisa et al. US Pat. No. 5,845,263 as discussed in paragraph 8 of paper number 5.

Further, Camaisa teaches that said customer device being moved by a customer from a first position to a second position, said second position being within range of said wireless transmission, said order information being received after said customer device is moved to said second position (column 4, lines 17-63, column 6, lines 26-52, column 11, lines 20-45, column 12, line 61 thru column 13, line 10, and column 14, lines 20 -34).

Response to Arguments

10. Applicant's arguments filed September 8, 2000 have been fully considered but they are not persuasive.

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In the remarks, the applicant argues in substance that;

Camaisa reference does not appear to disclose that the customer device is being moved from a first position to a second position, wherein the second position is within range of the repeatedly transmitted signal. Applicant argues that Camaisa's wireless customer terminal is an on-premise device, and while Camaisa does contemplate a remote customer terminal, the terminal is connected via modem, Camaisa does not deal with the concerns of range or of signal timing.

In response to the above arguments;

Camaisa clearly teaches that the portable interactive device is positioned within range of said wireless transmission when displaying said menu items (column 4, lines 37-58, and figs. 8-12), the fact that the device is moved from a first position to a second position is irrelevant, since the device is operative only when it is in the second position which is in range of the transmission signal. The first position is mentioned only to indicate that the device is out of network range, and Camaisa discusses the use of the device when it is in range of the transmitted signal, since the device is portable, it is clear that the device had to be moved from a first position to a second position to be within range.

As one of the embodiments, Camaisa does contemplate a remote customer terminal, and the terminal is connected via modem. However, that does not indicate that Camaisa does not deal with the concerns of range or of signal timing. Camaisa uses a wireless network including a radio frequency (rf) or infrared (IR) transmitter for transmitting signals (column 6, lines 26-52, and column 12, line 61 thru column 13, line 10), these wireless networks clearly have to be concerned

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with range and signal timing. Also, The wireless customer terminal of Camaisa is not only an on-premise device, column 6, lines 38-52 of Camaisa shows that the device such as the remote terminal 132 can be located in private residence.

Conclusion

11. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1065.

Serial Number: 09/238,821

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The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Hani Kazimi

November 16, 2000


MELANIE A. KEMPER
PRIMARY EXAMINER

ATTACHMENT TO AND MODIFICATION OF
NOTICE OF ALLOWABILITY (PTO-37)
(November, 2000)

NO EXTENSIONS OF TIME ARE PERMITTED TO FILE CORRECTED OR FORMAL DRAWINGS, OR A SUBSTITUTE OATH OR DECLARATION, notwithstanding any indication to the contrary in the attached Notice of Allowability (PTO-37).

If the following language appears on the attached Notice of Allowability, the portion lined through below is of no force and effect and is to be ignored¹:

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE **THREE MONTHS** FROM THE "DATE MAILED" of this Office action. Failure to comply will result in ABANDONMENT of this application. ~~Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).~~

Similar language appearing in any attachments to the Notice of Allowability, such as in an Examiner's Amendment/Comment or in a Notice of Draftperson's Patent Drawing Review, PTO-948, is also to be ignored.

¹ The language which is crossed out is contrary to amended 37 CFR 1.85(c) and 1.136. See "Changes to Implement the Patent Business Goals", 65 Fed. Reg. 54603, 54629, 54641, 54670, 54674 (September 8, 2000), 1238 Off. Gaz. Pat. Office 77, 99, 110, 135, 139 (September 19, 2000).

A Brief Summary of Some Significant Rule Changes

*Unless otherwise specified in the rule, the effective date for the PBG-FINAL RULE is November 7, 2000.

Amendment Practice (37 CFR 1.121)•

- Specification/Claims
 - Amendment by paragraph replacement or rewritten claim in clean form
 - Marked-up version showing changes must be supplied

See § 1.121 Slides on PBG-FINAL RULE Webpage for suggested amendment FORMAT (Optional now; mandatory March 1, 2001)

Small Entity Status (37 CFR 1.27) - FORMS NO LONGER REQUIRED (Eff. Sept. 8, 2000):

- Mere written assertion (e.g., use check box on Application Transmittal Forms) is acceptable

Abstract and Title Length (37 CFR 1.72)

- Abstract now limited to 150 words (PBG)
- Title now limited to 500 characters (AIPA)

Application Data Sheet (ADS) (37 CFR 1.76) NEW

- Use of ADS encouraged for more accurate capture of bibliographic data. Data in ADS not needed in declaration.

After Allowance Practice (37 CFR 1.85(c) and 1.136)

- No extensions of time permitted to file corrected or formal drawings

Elimination of Issue Fee Preauthorizations (37 CFR 1.311)

- Preauthorizations prior to Notice of Allowance no longer permitted

Rocket Docket Established for Designs (37 CFR 1.155)

- Extra submissions plus \$900 fee is required

Proof of Authority of Legal Representative (37 CFR 1.44)

THIS RULE HAS BEEN DELETED. (Eff. Sept. 8, 2000):

- Oath/Dec. (§1.63) should identify legal rep for deceased/incapacitated inventor

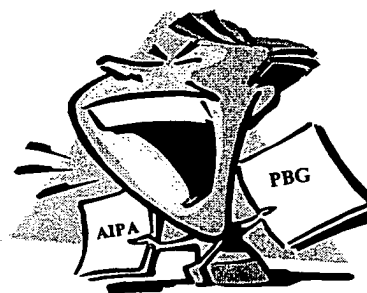
Parts of Applications on CD-R or CD-ROM (37 CFR 1.52 (e), 1.58, 1.96 & 1.821)

- Large tables, computer program listings, and bio-sequences now allowed on CD

Patent Business Goals Final Rule

65 Fed. Reg. 54604 (September 8, 2000)

1238 Off. Gaz. Pat. Office 77 (September 19, 2000)



USPTO's PBG-FINAL RULE webpage has helpful related information at one location:

<http://www.uspto.gov/web/offices/dcom/olia/pbg/index.html>

This site includes:
a Listing of Affected Rules,
Training & Implementation
Materials including Training
Slides, Q & A's, Summaries,
Effective Date Chart, Forms
Changed by Recent Rules, etc.

Contact:

Bob Spar (703) 308-5107 or
Hiram Bernstein (703) 305-8713
for any PBG Change.

Joe Narcavage (703) 305-1795
for 37 CFR 1.121
Amendment Practice Changes

Eugenia Jones (703) 306-5586
for 37 CFR 1.27 Small Entity
Changes